

REMARKS

Reconsideration and withdrawal of the rejections set forth in the above-mentioned Office Action in view of the following remarks are respectfully requested.

Claims 1, 4-18, 20-22 and 25-53 are currently pending in the application, with Claims 1, 38 and 50 being the independent claims. Applicants submit that no new matter has been added.

In the Office Action, Claims 1, 38 and 50 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over Claim 1 of U.S. Patent No. 6,676,254 (Nagashima et al. '254) in view of U.S. Patent No. 6,302,530 (Shimada et al.). Claims 1, 38 and 50 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over Claim 1 of Nagashima et al. '254 in view of U.S. Patent No. 5,953,031 (Omata et al.). Claims 1, 4-18, 20-22, 25-37 and 51 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent No. 6,676,734 (Nagashima et al. '734) in view of Shimada et al. Claims 38-50, 52 and 53 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Nagashima et al. '734 in view of Shimada et al. These rejections are traversed.

Applicants' invention as recited in independent Claim 1 is directed to a recording method including a step of providing an ink from a recording head to a recording medium through a gap provided between the recording head and the recording medium. The ink is supplied to the recording head from an ink tank including an ink contact member and the ink contacting the ink contact member. The ink includes (i) a fluorescent coloring material; (ii) a nonionic surfactant; (iii) a compound which is not compatible with (ii); and (iv) a liquid medium for dissolving or dispersing (i), (ii) and (iii). The ink contact member is an ink-holding member made of polypropylene.

Applicants' invention as recited in independent Claim 38 is directed to an ink-cartridge including an aqueous ink and an ink contact member. The ink includes (i) a fluorescent

coloring material; (ii) a nonionic surfactant; (iii) a compound which is not compatible with (ii); and (iv) a liquid medium for dissolving or dispersing (i), (ii) and (iii). The ink contact member is an ink-holding member made of polypropylene.

Applicants' invention as recited in independent Claim 50 is directed to an ink tank including an aqueous ink, an ink container and an ink-holding member. The ink includes (i) a fluorescent coloring material; (ii) a nonionic surfactant; (iii) a compound which is not compatible with (ii); and (iv) a liquid medium for dissolving or dispersing (i), (ii) and (iii). The ink-holding member includes polypropylene.

Regarding the double-patenting rejections, Applicants submit that one of ordinary skill in the art would not have been motivated to combine Nagashima et al. '254 with either Shimada et al. or Omata et al. without some specific teaching that polypropylene is advantageous for constructing an ink tank holding a fluorescent coloring material. This is especially true in light of the fact that neither Shimada et al. nor Omata et al. describe suitable ink compositions. Accordingly, Applicants respectfully request reconsideration and withdrawal of the double-patenting rejections. Nevertheless, if the Examiner maintains the rejections, Applicants will consider filing a terminal disclaimer when the other rejections have been overcome.

Nagashima et al. '734 is directed to an ink having first and second organic compounds which are incompatible with each other, at least one of a compound exhibiting fluorescence properties and a coloring material exhibiting fluorescence properties, and a liquid medium. Nagashima et al. '734 also discloses that an ink container for holding the ink may be made from polyurethane, cellulose, polyvinyl acetate, polyolefin or a polymer formed by a condensation reaction of organic compounds. The Examiner acknowledges, however, that Nagashima et al. '734 does not disclose polypropylene. To remedy this deficiency, the Examiner cites to Shimada et al.

Shimada et al. is directed to an ink cartridge that may be made from polypropylene. The Examiner suggests that one of ordinary skill in the art would be motivated to

modify the ink container of Nagashima et al. with the polypropylene disclosed in Shimada et al. so as to obtain a low cost ink cartridge that is moldable and has a low vapor permeability.

Applicants respectfully disagree.

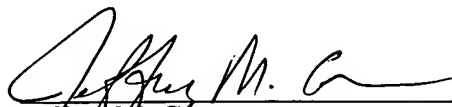
Applicants submit that the Examiner's proposed combination is based on impermissible hindsight. That is, the Examiner has merely chosen Shimada et al. for reciting polypropylene as well as a general advantage for use of the polypropylene, rather than an advantage for use of polypropylene for storing an ink having a fluorescent coloring material. Applicants note that Shimada et al. does not teach or suggest that polypropylene would be suitable for use with an ink having a fluorescent coloring material. In fact, Shimada et al. does not provide any disclosure as to the types of ink that would be suitable for use with the disclosed ink cartridge. Thus, it does not necessarily follow that the advantages identified by the Examiner would become manifest if the components were combined in the suggested manner. Thus, the rejections are not well-founded. As such, Applicants submit that the cited art, whether taken alone or in combination does not teach or suggest that the ink contact member is an ink-holding member made of polypropylene, as recited in Claims 1 and 38, or that the ink contact member is an ink-holding member made of polypropylene, as recited in Claim 50. Applicants respectfully request reconsideration and withdrawal of the rejections under § 103.

For the foregoing reasons, Applicants submit that the present invention is patentably defined by independent Claims 1, 38 and 50. Dependent Claims 4-18, 20-22, 25-37, 39-49 and 51-53 are also patentable, in their own right, for defining features of the present invention in addition to those recited in the independent claims. Individual consideration of the dependent claims is requested.

Applicants submit that the application is in condition for allowance. Favorable reconsideration and withdrawal of the rejections set forth in the above-noted Office Action, and an early Notice of Allowance are requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jeffrey M. Connor", written over a horizontal line.

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